REMARKS

Claims 11-13 have been cancelled. Claim 7 has been amended to correct a typographical error.

Claims 1-13 were rejected under 35 USC §102(b) as being anticipated by JP 06-032747 ('747) . This rejection is respectfully traversed. For a prior art reference to anticipate a set of claims, each and every limitation of the claims must be disclosed in that reference. *Glaxo v. Novopharm*, 34 USPQ2d 1565 (Fed. Cir. 1995). Claims 11-13 have been cancelled. Claim 1, 4 and 9 have been amended such that the lower limit of phenolic compound content in the feed is at least 1.3% by weight. Support for this amendment may be found in the specification in paragraph [0008] of the present Application. The highest amount the '747 reference discloses is 1%, (paragraph [0014]) but none of the examples are more than 0.81%. Therefore, each limitation is not disclosed in the '747 reference. Subsequently, Applicants believe this reference does not anticipate the rejected claims and respectfully request the rejection be withdrawn.

Claims 11-13 were rejected under 35 USC §102(b) as being anticipated by WO 02/26680; US 5,015,787; US 6,015,927; US 6,215,030. Claims 11-13 have been cancelled. Therefore, Applicants respectfully request the rejection be withdrawn.

Claims 1-13 were rejected under 35 USC §103(a) as being unpatentable over the '747 reference. This rejection is respectfully traversed.

To establish a *prima facie* basis for obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure [MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).]

Claims 11-13 have been cancelled. Claim 1, 4 and 9 have been amended such that the lower limit of phenolic compound content in the feed is at least 1.3% by weight. The object of the '747 reference is the hydrogenation of a feed of acetophenone and styrene. The presence of phenolic compounds in this feed seems to be merely the result of an incomplete separation process in a prior step as indicated in paragraph [0014] of the reference. There seems to be no suggestion in the reference that phenolic compounds in the feed may actually have beneficial results for the hydrogenation reaction. Therefore, there would be no expectation of particular success upon increasing the amount of phenolic compounds in the

feed, as in the present invention. Therefore, Applicants believe a *prima facie* basis for obviousness has not been established, and respectfully request that the rejection be withdrawn.

Claims 11-13 were rejected under 35 USC §103(a) as being unpatentable over WO 02/26680; US 5,015,787; US 6,015,927; US 6,215,030. Claims 11-13 have been cancelled. Therefore, Applicants respectfully request the rejection be withdrawn.

CONCLUSION

In view of the above amendments and remarks, Applicants believe the instant application to be in condition for allowance and respectfully request that such action be taken.

Respectfully submitted,
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